

### **REMARKS**

Responsive to the Office Action mailed October 20, 2006, Applicants provide the following. Claims 17 and 20 are amended to correct errors relative to previous amendments, and no new matter is added by these amendments. New claim 21 was added. Therefore, nineteen (19) claims remain pending in the application: Claims 1-11 and 14-21. Reconsideration of claims 1-11 and 14-20 and consideration of claim 21 in view of the remarks below is respectfully requested.

By way of this amendment, Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues that require adverse action, it is respectfully requested that the Examiner telephone the undersigned at (858) 552-1311 so that such issues may be resolved as expeditiously as possible.

### **Claim Rejections - 35 U.S.C. §103**

Claims 1-11 and 14-20 stand rejected under 35 U.S.C. § 103 (a), as being unpatentable over U.S. Patent No. 6,141,003 (Chor et al.). Applicants respectfully traverse these rejections and submit that claims 1-11 and 14-20 are not obvious in view of the Chor patent and that the Chor patent fails to teach all of the limitations as recited in at least independent claims 1 and 11.

Applicants respectfully submit that in rejecting claims 1-11 and 14-20 the office action fails to show that the Chor patent teaches each limitation as recited in at least claim 1, and Applicants further submit that it would not be obvious in view of Chor to provide all of the limitations as recited in at least claim 1. Specifically, the office action rejecting claim 1 states that Chor does not teach a remove icon but continues suggesting that one skilled in the art would alter the Chor patent to "at least create 'remove' icon so as to match the 'add' icon and to facilitate removal of channels" (office action, page 3). However, the office action fails to show that one skilled in the art would replace the add icon with the remove icon as recited in claim 1. Therefore, the

Chor patent does not teach each limitation as recited in claim 1 and the office action has failed to demonstrate that it would have been obvious to alter Chor to include each limitation as recited in claim 1.

Applicants further respectfully submit that one skilled in the art would not alter the Chor patent to replace the add icon with a remove icon and Chor fails to suggest replacing an add icon with a remove icon. Instead, Chor already describes alternative methods for removing entries in the list, and thus, it would not be obvious to alter Chor to replace the add icon with the remove icon. Further, Applicants respectfully submit that the office action fails to provide any motivation for at least altering Chor to replace the add icon with a remove icon. Even if, *arguendo*, one skilled in the art would add a remove icon to the user interface of Figure 2 of Chor, one skilled in the art would not replace the add icon with the remove icon and there is no motivation to replace the add icon with a remove icon. Still further, one skilled in the art would not be motivated to alter the Chor patent to replace the add icon with the remove icon as the Chor patent already provides a method to remove entries and further, one skilled in the art would not appreciate the benefits without the benefit of hindsight provided by the subject application. Therefore, Applicants respectfully submit that the Chor patent fails to teach each limitation as recited in claim 1, and further, one skilled in the art would not alter the Chor patent as recited in claim 1.

Furthermore, the Chor patent also does not teach or suggest, and it would not have been obvious to one skilled in the art to alter the Chor patent to include “an add icon ... when the current channel is not stored in said memory and displaying a remove icon in place of the add icon ... when the current channel is stored in said memory” as recited in claim 1. Claim 1 recites that the add icon is not simply displayed, but instead is displayed when the current channel is not store, and further, the remove icon is not simply displayed but instead is displayed in place of the add icon, and still further, the remove icon is displayed when the current channel is store. The Chor patent does not teach or suggest the remove icon, or the displaying of the remove icon in place of the

add icon, or the displaying of a remove icon when the current channel is stored and in place of the add icon. Additionally, the office action fails to show where the Chor patent teaches at least these limitations, and further fails to show that it would be obvious to alter the Chor patent to include at least these limitations. Therefore, Applicants respectfully submit that the office action fails to show that the Chor patent teaches each limitation as recited in at least claim 1, and thus, claim 1 is not obvious in view of the Chor patent.

Additionally, Applicants have demonstrated in the previous response that it would not be obvious to one skilled in the art to alter the Chor patent to include a remove icon or a remove icon in place of an add icon. In part, Chor already provides a method of removing entries to the channel list. Therefore, one skilled in the art would not be motivated to provide a remove icon. Further, there is no suggestion or motivation in Chor to provide a remove icon in place of the add icon. Thus, at least claim 1 is not obvious over the Chor patent.

Applicants have distinguished the pending claims over the Chor patent in response to the three (3) previous office actions. It was shown that the combination of the Chor patent in view of U.S. Patent No. 6,571,390 to Dunn et al. did not teach all of the limitations as recited in at least claims 1 and 11, and further, that the Chor patent under 35 U.S.C. §102 failed to teach each limitation as recited in at least claims 1 and 11.

The Examiner now relies on common knowledge taking official notice without supporting evidence that it would have been obvious to alter the Chor patent so as to suggest all of the limitations as recited in claim 1. Applicants respectfully traverse this official notice and request evidence to support the contention that it would be obvious to change the Chor patent to include all of the limitations as recited at least in claims 1 and 11. MPEP Section 2144.03(A) specifically states:

Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common

knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “capable of such instant and unquestionable demonstration as to defy dispute” (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

Applicants respectfully submit that the facts asserted by the Examiner are not well-known or capable of instant and unquestionable demonstration of being well-known. Instead, the Examiner has attempted in the past to demonstrate the obviousness by citing other references (e.g., the Dunn patent) where Applicants were successful in demonstrating that it would not be obvious to alter the Chor patent as suggested by the Examiner to include a delete button as claimed in view of the Dunn patent (MPEP 2144.03(C)). Further, the MPEP at Section 2144.03(E) states that:

rejection[s] based on assertions ... [of] common knowledge ... should be judiciously applied ... [and] any facts so noticed should be of notorious character and serve only to ‘fill in the gaps’ in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection.

The assertion that one skilled in the art would alter the Chor patent to include a remove icon or to alter the Chor patent to provide a remove icon in place of the add icon is not applied “to ‘fill in the gaps’ in an insubstantial manner” and instead attempts to negate entire claim limitations that Applicants have already demonstrated as not being taught by the Chor patent, not being obvious over Chor and further overcame evidentiary support based on the previously cited Dunn patent that one skilled in the art would alter the Chor patent to include the recited remove icon.

It is further noted, that the MPEP at Section 2144.03(B) continues stating that:

... general conclusions concerning what is ‘basic knowledge’ or ‘common sense’ to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). In certain older cases, official notice has

been taken of a fact that is asserted to be ‘common knowledge’ without specific reliance on documentary evidence where the fact noticed was readily verifiable, such as when other references of record supported the noticed fact, or where there was nothing of record to contradict it (citing *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697, emphasis added).

Applicants respectfully submit that the Examiner has in previous office actions attempted to provide evidentiary support citing other references that one skilled in the art would alter the Chor patent to include a remove icon. However, Applicants demonstrated that one skilled in the art would not alter Chor as suggested in the previous office action to at least include the remove icon as claimed. Therefore, the prosecution record clearly contradicts the unsupported assertion that one skilled in the art would include the remove icon as recited at least in claim 1. Applicants respectfully request that the general assertion without concrete evidence to support the assertion that one skilled in the art would alter the Chor patent to include the remove icon is in error and should be withdrawn.

Further, the MPEP at Section 2144.03(A) stating:

It is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. (MPEP 2144.03(A), citing *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697)

Again, Applicants respectfully submit that prior office action tried to demonstrate the obviousness of the claims in view of the combination of the Chor and Dunn patents, and Applicants successfully distinguished the claims over the combination. The office action in rejecting claim 1 has done so relying solely on official notice of what the Examiner suggests is “common knowledge” without concrete evidentiary support. Instead the Examiner previously attempted to show evidentiary support that Applicants were successful in overcoming. Therefore, with all due respect Applicants submit that taking such official notice was in error and request that the rejection be withdrawn.

Claim 11 includes similar language as that recited in claim 1, providing a “menu including a first icon selectable to add the current channel to a list ... and including a second icon in place of the first icon ... to remove the current channel from the list ... when the current channel is currently stored in the list of channels” (claim 11). Again, the assertion without evidentiary support that it would have been obvious to one skilled in the art to alter the Chor patent to include a selectable icon to remove a current channel from the listing in place of a first icon when the channel is stored in memory. Therefore, claim 11 is also not obvious in view of the Chor patent.

Claims 2-10 and 14-20 depend from claims 1 and 11, respectively. Therefore, claims 2-10 and 14-20 are also not obvious due at least to their dependency claims 1 and 11.

Further with regard to at least claim 18, Applicants respectfully submit that Chor fails to teach or describe at least a “second screen menu further comprises a graphical portion, said list of channels being scrollable, said graphical portion displaying a show corresponding to a channel in said list during scrolling” as recited by claim 18. There is no teaching or suggestion in Chor to display a screen menu with a scrollable listing of channels and a graphical portion displaying shows corresponding to the channels during scrolling. Instead, Chor requires the user to click upon the icon currently having focus (or other similar action such as a keystroke) in order to view the show corresponding to the channel stored in memory (Chor, col. 8, lines 39-67). The office action generally rejects claims 17-20 citing col. 6, line 32 – col. 7, line 21, col. 8, line 39 – col. 9, line 21 and line 46 – col. 10, line 24. However, the cited portions do not describe a second menu having both the graphical portion and scrollable list with the graphical portion displaying a show corresponding to a channel in the list.

Regarding at least claim 19, Applicants respectfully submit that Chor fails to teach or describe at least the secondary menu further comprising a text portion including a description of the show corresponding to the channel in the list of channels stored in memory as recited by claim 19. The channel bars displaying the stored channels

described by Chor are a set of linearly arranged actuatable icons associated with a particular stored channel (Chor, col. 2, lines 39-41 and 48-50). The channel bars described in Chor do not comprise a text portion providing a program description for the show corresponding to a channel stored in memory. At best, Chor describes a banner for displaying program information (Chor col. 5, lines 40-55) as part of the full channel bar user interface. This banner displays the program information for the “presently selected channel” (Chor, col. 2, lines 22-32) that the user has selected for viewing. However, Chor does not describe using the banner to display a description of a show corresponding to a channel stored in memory while scrolling through the list of channels in memory as recited in claim 19. Therefore, Chor does not describe at least each element of claim 19.

#### **New Claim**

New claim 21 recites that “the second screen menu further comprises an instruction displayed in the graphical portion and superimposed over the show displayed in the graphical portion, with the instructions defining how to display the channel depicted in the graphical portion.” Support for new claim 21 can be found in the application as filed, for example, at least on page 10, lines 1-13. The Chor patent fails to teach or suggest a second menu as claimed, and further fails to teach or suggest a menu with a graphical portion and instructions superimposed over the show displayed in the graphical portion. Therefore, claim 21 is also not obvious over the Chor patent.

**CONCLUSION**

Applicants submit that the above remarks place the pending claims in a condition for allowance. Therefore, a Notice of Allowance is respectfully requested.

Respectfully submitted,

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